

PATENT

Atty. Dkt. No. SEDN/PRED144
Serial No. 09/928,493**REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed January 6, 2005, in which the Examiner rejected pending claims 1-28.

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated under the provisions of 35 U.S.C. §102.

It is to be understood that the Applicants do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

Rejections**35 U.S.C. §102****Claims 1-58**

The Examiner has rejected claims 1-58 as being anticipated by Herz U.S. Patent 6,029,195 (hereinafter "Herz"). The Applicants respectfully traverse the rejection.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added)). The Herz reference fails to disclose each and every element of the claimed invention, as arranged in the claim.

Claim 1 recites, *inter alia*, "comparing (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween". Herz fails to disclose at least these elements of claim 1. In the section cited in the Office Action for these elements, Herz discloses comparing "target profiles" of "target objects" with "search profiles" of users. (Herz, col. 7, lines 9-18). Herz is not comparing the same things as the claimed invention. Herz defines "target objects" as "an object available for access by the user" and "target profiles" as "a digitally represented profile indicating that target object's attributes". (Herz, col. 4, lines 49-53). Herz defines a "search profile" as "a

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profile consisting of a collection of attributes, such that a user likes target objects whose profiles are similar to this collection of attributes". (Herz, col. 4, lines 57-61). The claimed invention compares the current user's identified activities and surrounding conditions with the other users' cumulative activities and surrounding conditions. The current user's identified activities and surrounding conditions are different than the "target profiles" of "target objects", because the user is not an object available for access; by contrast the user is the one doing the accessing. Other users' cumulative activities and surrounding conditions are not "search profiles", because activities are not attributes; attributes are generalized qualities, while activities are specific tasks. Therefore, Herz fails to disclose at least these elements of claim 1. Thus, claim 1 is not anticipated by Herz.

Claim 17 recites, *inter alia*, "comparing (i) the user's present activities and surrounding conditions and (ii) the cumulative activities and surrounding conditions as reflected in such first collection of data, to identify similarities therebetween". For the same reasons as given above with respect to claim 1, claim 17 is not anticipated by Herz.

Claim 22 recites, *inter alia*, "comparing (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween". For the same reasons as given above with respect to claim 1, claim 22 is not anticipated by Herz.

Claim 35 recites, *inter alia*, "comparing (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween". For the same reasons as given above with respect to claim 1, claim 35 is not anticipated by Herz.

Claim 46 recites, *inter alia*, "means for comparing (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween". For the same reasons as given above with respect to claim 1, claim 35 is not anticipated by Herz.

As such, the Applicants submit that independent claims 1, 17, 22, 35 and 46 are not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Furthermore, claims 2-16, 18-21, 23-34, 36-45 and 47-58 depend, either

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directly or indirectly, from independent claims 1, 17, 22, 35 and 46 and recite additional features thereof. As such and at least for the same reasons as discussed above, the Applicants submit that these dependent claims are also not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

SECONDARY REFERENCES

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the Office Action. Therefore, the Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

CONCLUSION

Thus, the Applicants submit that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. §102. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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